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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/814,441
Filing Date: March 22, 2001
Appellant(s): CALAWAY ET AL.

Alan M. Kagen
(Reg. No. 36, 178)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 19, 2008 appealing from the Office action mailed September 25, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20010037373	Cambridge	11-2001
20020026374	Moneymaker et al.	2-2002
6,026,376	Kenney	2-2000

5,918,213 Bernard et al. 6-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 7-15, 18-25, 27, 30, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cambridge (US 2001/0037373 A1) in view of Moneymaker (US 2002/0026374 A1).

Cambridge discloses electronically initiating a purchase of an item using a computer (Cambridge: par. 0048).

A data storage medium having at least one image of at least one item stored thereon is provided (Cambridge: par. 0047); an image of an item from the storage medium is accessed (Cambridge: par. 0069); the accessed item image is viewed on a display in communication with a local processor (Cambridge: par. 0061); the item for purchase is electronically selected for purchase (Cambridge: par. 0064) causing purchase data on the item to be stored on a writable memory device in communication

with the local processor (Cambridge: par. 0065); and a first selection and a second selection are permitted.

All purchase data not supplied by a consumer is supplied by the data storage medium (Cambridge: par. 0067).

The first selection causes printing of an order form configured to initiate a purchase when physically delivered to a vendor (Cambridge: par. 0078).

The second selection causes storing of the purchase data on a device accessible by the local processor (Cambridge: par. 0091).

The at least one image comprises a three-dimensional image; and the user is permitted to selectably rotate the image (Cambridge: par. 0071).

Two sets of images as well as other promotional material is disclosed (Cambridge: par. 0070).

The method is completed without having accessed information related to the item not already contained by the removable data storage medium (Cambridge: par. 0061).

Cambridge further discloses means for establishing communication between the processor and an external network (Cambridge: par. 0068).

Purchase data may be transferred to a vendor (Cambridge: par. 0068).

Even though Cambridge discloses initiating the purchase of the item without accessing the Internet (Cambridge: par. 0048), Cambridge does not expressly disclose completing the purchase of the item without accessing the Internet.

Moneymaker, in a similar invention (Moneymaker: abstract), teaches completing the purchase of the item without accessing the Internet (Moneymaker: par. 0027, “The

final ordering form will also enable an interested party to select whether he or she is going to pay online, by means of a credit card or EFT, or whether the interested party is going to pay offline, by means of cash or check.").

It would have been obvious to one of ordinary skill in the art to have modified the purchasing method and system of Cambridge to complete the purchase without accessing the Internet in order to eliminates mistakes and delays associated with transmitting credit card and/or EFT data, or other electronic payment data, to each particular merchant who receives an online order and who is then forced to transmit the received credit card and/or EFT data to his or her own third-party credit card processor (Moneymaker: par. 0012).

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cambridge (US 2001/0037373 A1) and Moneymaker (US 2002/0026374 A1) in view of Kenney (U.S. Patent No. 6,026,376).

Neither Cambridge nor Moneymaker discloses that the image comprises an electronic switch means.

Kenney, in a similar invention (col. 1, lines 37-54), teaches "clicking" on a product in a virtual environment (col. 10, lines 45-53).

It would have been obvious to one of ordinary skill in the art to have provided the image of Cambridge and Moneymaker as comprising an electronic switch means in order to automatically add an item represented by the image of Cambridge to a selected product list (Kenney: col. 12, lines 55-63).

Claims 29, 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cambridge (US 2001/0037373 A1) and Moneymaker (US 2002/0026374 A1) in view of Bernard et al. (U.S. Patent No. 5,918,213).

Neither Cambridge nor Moneymaker discloses a reminder.

Bernard, in a similar invention (Abstract), teaches means for providing a reminder that pending purchase data remains (col. 5, line 61-col, 6, line 10).

It would have been obvious to one of ordinary skill in the art to have provided the invention of Cambridge and Moneymaker to have included a means for providing a reminder (at processor startup or otherwise) that pending purchase data remains (on the device or elsewhere) in order to have provided added convenience to the shopper in the event that the a transaction has not previously been completed (col. 6, lines 7-10).

(10) Response to Argument

In the Appeal Brief, Appellants argue:

1. Cambridge and Moneymaker fail to teach "initiating and completing the purchase of the item without accessing the Internet".

1. Cambridge and Moneymaker explicitly teach "initiating and completing the purchase of the item without accessing the Internet".

In response to Appellants argument Cambridge and Moneymaker fail to teach "initiating and completing the purchase of the item without accessing the Internet", Examiner respectfully disagrees. Moneymaker teaches that order completion can be done in an offline environment (see Moneymaker paragraph 27). Furthermore, Moneymaker explicitly teaches that an order form can be downloaded on to a

purchaser's computer (see Moneymaker paragraph 28) and the purchaser initiates the ordering process by entering order information (see Moneymaker 26). As described in Moneymaker Figure 1 and paragraph 26, the initiation of an order takes place when a purchaser begins to fill out an order form. Since the order form resides on the purchaser's computer after download, the initiation of the order (i.e. the filling out of the order form) is done without the Internet. As such, Moneymaker clearly describes a system where the initiation and completion of the purchasing or ordering of an item is done without accessing the Internet. Therefore, Examiner's previously asserted 35 U.S.C. 103 rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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